

**O/1066/25**

**TRADE MARKS ACT 1994**

**CONSOLIDATED PROCEEDINGS**

**IN THE MATTER OF APPLICATION NOS.**

**4028913 AND 4028915**

**BY FRAYS BRANDS LTD**

**TO REGISTER THE TRADE MARKS:**

**SOL SLEEP**

**AND**

**SOL BEACH**

**IN CLASSES 25 AND 35**

**AND**

**IN THE MATTER OF OPPOSITION THERETO**

**UNDER NOS. 448941 AND 448942**

**BY SOLO INVEST**

## BACKGROUND AND PLEADINGS

1. On 20<sup>th</sup> March 2024, Frays Brands Ltd (“the applicant”) applied to register the trade marks shown on the cover of this decision in the United Kingdom. The applications were accepted and published in the Trade Marks Journal on 3<sup>rd</sup> May 2024, in respect of the following goods and services:

**Class 25:** Clothing; Footwear; Headgear; Hooded sweatshirts; Shirts; Sweatshirts; T-shirts; Vests; Underwear; Hats; Berets; Knitted headwear; Sportswear; Dresses; Skirts; Blouses; Belts; Waist Belts; Coats; Jackets; Knitwear; Jumpers; Tights; Socks; Loungewear; Bathrobes; Capes; Evening wear; Gowns; Trousers; Shorts; Jeans; Suits; Neckwear; Nightwear; Outerclotthing; Rainwear; Ties; Pyjamas; Pajamas; Lingerie; Nightgowns; Nighties; Nightdresses; Sleepwear; Sleep masks; Sleeping garments; One-piece suits; Negligees; Beachwear; Beach clothing; Beach hats; Beach robes; Beach wraps; Beach footwear; Beach shoes; Beach cover-ups; Sandals; Flip-flops; Swimwear; Swimming costumes; Swimming trunks; Swimming suits; Sun suits; Sun hats; Hats; parts, accessories or fittings for the aforesaid.

**Class 35:** Advertising; business management; business administration; office functions; Advertising, marketing, promotion or publicity services; Business advice, assistance or information services; Business management; Management advice, assistance or information services; Online advertising on computer networks; Sales promotion services; Mail order retail services, wholesale services, retail services or Internet retail services connected with the sale of Clothing, Footwear, Headgear, Hooded sweatshirts, Shirts, Sweatshirts, T-shirts, Vests, Underwear, Hats, Berets, Knitted headwear, Sportswear, Dresses, Skirts, Blouses, Belts, Waist Belts, Coats, Jackets, Knitwear, Jumpers, Tights, Socks, Loungewear, Bathrobes, Capes, Evening wear, Gowns, Trousers, Shorts, Jeans, Suits, Neckwear, Nightwear, Outerclotthing, Rainwear, Ties, Pyjamas, Pajamas, Lingerie, Nightgowns, Nighties, Nightdresses, Sleepwear, Sleep masks, Sleeping garments, One-piece suits, Negligees, Beach clothing, Beach hats, Beach robes, Beach wraps, Beach footwear, Beach shoes, Beach cover-ups, Sandals, Flip-flops,

Swimwear, Swimming costumes, Swimming trunks, Swimming suits, Sunsuits, Sun hats, Hats, Luggage, Bags, Wallets, parts, accessories or fittings for the aforesaid; Information, advice or consultancy services relating to the aforesaid.

2. On 2<sup>nd</sup> August 2024, Solo Invest (“the opponent”) opposed the applications based on Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The oppositions are directed only against those goods and services that are underlined above. The opponent relies upon the mark shown below:



**UK00918185631**

Filing date: 20<sup>th</sup> January 2020, French priority date: 22<sup>nd</sup> July 2019,  
Registration date: 22<sup>nd</sup> May 2020

Relying upon the following goods:

**Class 18:** *Handbags; Gentlemen's handbags; Carrier bags; Shoulder bags; Belt bags (hipsacks); Wrist mounted carryall bags; Pouches (bags); Evening bags; Backpacks; Shopping bags; Carrier bags; Wheeled shopping bags; Garment bags for travel; Travel cases; Vanity cases, not fitted; Travel garment covers; Travelling bags; Beach bags; Gym bags; Sport bags; Bags for climbers; Bags for campers; Satchels; Briefbags; Wallets; Credit card holders; Purses; Trunks and travelling bags; Umbrellas; Parasols; Leather leashes; Whips.*

**Class 24:** *Textiles; Bed and table covers; Materials for soft furnishings, Curtains of textile or plastic; Wall hangings of textile; Linens; Bath linen (except clothing), bath towels, washing mitts and towels; Bed linen, covers, sheets, pillowcases, eiderdowns and duvets (down coverlets), lap rugs; Table linen, table cloths, place mats and table napkins, not of paper; Labels of textile; Flags of textile or plastic.*

**Class 25:** *Clothing; Jeans, dresses, skirts, suits, jackets (clothing), trousers, shorts, Bermuda shorts, dungarees, combinations, shirts, smocks, T-shirts, sweatshirts, tank tops, pullovers; Knit shirts, Gloves [clothing], Mittens, Knitted*

*jumpers, knit skirts, Knitted dresses; Waistcoats, tracksuits, coats, parkas, waterproof clothing, petticoats, topcoats, wind-resistant jackets, cloaks, ponchos, swimsuits, underclothing, stockings, tights, socks, boxer shorts, leggings, camisoles, scarves, sleep masks, baby-doll pyjamas, nighties, dressing gowns, bath robes, lingerie, layettes (clothing), pyjamas, belts, neckties, gloves, stoles, shawls, sashes for wear; Hats, caps, Caps (headwear), berets, Sun hats, Visors, Boaters, Balaclavas; Footwear, in particular flip-flops, Pumps footwear, Esparto shoes or sandals, Mules, Mules, slippers, Boots, half-boots, Deck shoes, Tennis shoes.*

3. The opponent's mark qualifies as an "earlier trade mark" in accordance with Section 6 of the Act, as its priority date is earlier than the filing date of the applicant's mark. Since the opponent's earlier mark had been protected for less than five years at the filing date of the applicant's mark, it is not subject to the use provisions specified in Section 6A of the Act.
4. Under Section 5(2)(b), the opponent claims that the applicant's marks are highly similar to the opponent's mark visually, orally and conceptually. It deems the goods in class 25 and services in class 35 are identical or similar to its registration. Therefore, that there exists a likelihood of confusion on the part of the public which includes a likelihood of association.<sup>1</sup>
5. The applicant filed a counterstatement denying the claims made. It argues that the average consumer, being reasonably observant and circumspect, would appreciate the differences between the marks. In terms of the goods and services, it states they may have dissimilar natures, purposes, trade channels and may not compete with or complement the registered services. Therefore, that the "different elements" in the signs and goods and services would mean that the average consumer would not be confused as to trade origin.<sup>2</sup>
6. In these proceedings, the opponent is represented by Withers and Rogers LLP and the applicant by Brand Protect Limited.

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<sup>1</sup> TM7 forms dated 3<sup>rd</sup> August 2024.

<sup>2</sup> Answer to Question 8 on TM8 forms dated 7<sup>th</sup> October 2024.

## EVIDENCE AND SUBMISSIONS

7. Neither party filed submissions during the evidence rounds. No hearing was requested though the opponent provided written submissions in lieu of a hearing. This decision is taken following careful consideration of all the papers before me. I have not summarised the submissions in full, but they will be referenced within this decision to the extent that is necessary.

## DECISION

### Section 5(2)(b)

8. Section 5(2)(b) of the Act is as follows:

“A trade mark shall not be registered if because–

...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

Section 5A states:

“Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

9. In considering the opposition under this section, I am guided by the following principles which are taken from the decisions of the Court of Justice of the European Union (“CJEU”) in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs)*

(“OHIM”), Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:<sup>3</sup>

## The principles

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant, but someone who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them they have kept in their mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

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<sup>3</sup> The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; and

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

## **COMPARISON OF GOODS AND SERVICES**

10. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court of the European Union (“GC”) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

11. The opponent's goods in class 25 represent its best case, therefore I will use this as the basis of my decision. I will return to the remaining classes following my goods and services comparison if necessary. Therefore, the goods and services to be compared are as follows:

The applicant's goods and services	The opponent's goods
<p><b>Class 25:</b> <i>Clothing; Footwear; Headgear; Hooded sweatshirts; Shirts; Sweatshirts; T-shirts; Vests; Underwear; Hats; Berets; Knitted headwear; Sportswear; Dresses; Skirts; Blouses; Belts; Waist Belts; Coats; Jackets; Knitwear; Jumpers; Tights; Socks; Loungewear; Bathrobes; Capes; Evening wear; Gowns; Trousers; Shorts; Jeans; Suits; Neckwear; Nightwear; Outerclotthing; Rainwear; Ties; Pyjamas; Pajamas; Lingerie; Nightgowns; Nighties; Nightdresses; Sleepwear; Sleep masks; Sleeping garments; One-piece suits; Negligees; Beachwear; Beach clothing; Beach hats; Beach robes; Beach wraps; Beach footwear; Beach shoes; Beach cover-ups; Sandals; Flip-flops; Swimwear; Swimming costumes; Swimming trunks; Swimming suits; Sunsuits; Sun hats; Hats; parts, accessories or fittings for the aforesaid.</i></p> <p><b>Class 35:</b> <i>Mail order retail services, wholesale services, retail services or</i></p>	<p><b>Class 25:</b> <i>Clothing; Jeans, dresses, skirts, suits, jackets (clothing), trousers, shorts, Bermuda shorts, dungarees, combinations, shirts, smocks, T-shirts, sweatshirts, tank tops, pullovers; Knit shirts, Gloves [clothing], Mittens, Knitted jumpers, knit skirts, Knitted dresses; Waistcoats, tracksuits, coats, parkas, waterproof clothing, petticoats, topcoats, wind-resistant jackets, cloaks, ponchos, swimsuits, underclothing, stockings, tights, socks, boxer shorts, leggings, camisoles, scarves, sleep masks, baby-doll pyjamas, nighties, dressing gowns, bath robes, lingerie, layettes (clothing), pyjamas, belts, neckties, gloves, stoles, shawls, sashes for wear; Hats, caps, Caps (headwear), berets, Sun hats, Visors, Boaters, Balaclavas; Footwear, in particular flip-flops, Pumps footwear, Esparto shoes or sandals, Mules, Mules, slippers,</i></p>

<p><i>Internet retail services connected with the sale of Clothing, Footwear, Headgear, Hooded sweatshirts, Shirts, Sweatshirts, T-shirts, Vests, Underwear, Hats, Berets, Knitted headwear, Sportswear, Dresses, Skirts, Blouses, Belts, Waist Belts, Coats, Jackets, Knitwear, Jumpers, Tights, Socks, Loungewear, Bathrobes, Capes, Evening wear, Gowns, Trousers, Shorts, Jeans, Suits, Neckwear, Nightwear, Outerclotthing, Rainwear, Ties, Pyjamas, Pajamas, Lingerie, Nightgowns, Nighties, Nightdresses, Sleepwear, Sleep masks, Sleeping garments, One-piece suits, Negligees, Beach clothing, Beach hats, Beach robes, Beach wraps, Beach footwear, Beach shoes, Beach cover-ups, Sandals, Flip-flops, Swimwear, Swimming costumes, Swimming trunks, Swimming suits, Sunsuits, Sun hats, Hats, parts, accessories or fittings for the aforesaid.</i></p>	<p><i>Boots, half-boots, Deck shoes, Tennis shoes.</i></p>
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**Class 25**

12. The opponent’s submissions regarding class 25 focus on both parties’ goods being “identical and similar...since they all cover clothing items for the human body”. In relation to footwear, it states its footwear items “are similar to the Applicant’s goods in class 25 since they would be considered clothing for the

feet”.<sup>4</sup>

“Headgear”, “hats”, “berets”, “knitted headwear”, “beach hats” and “sun hats”

13. These are all either identically found within the opponent’s specification or fall within its general term “hats” and would therefore be considered identical, according to the principles outlined in *Meric*.

“Beach footwear”, “beach shoes”, “sandals” and “flip-flops”

14. The opponent’s registration is limited to “Footwear, in particular flipflops, pumps footwear, Esparto shoes or sandals, mules, slippers, boots, half-boots, deck shoes, tennis shoes”. “Flipflops” and “flip-flops” are self-evidently identical. Further, the opponent’s “esparto sandals” would be encompassed by applicant’s “sandals” therefore these are identical according to *Meric*. The applicant’s remaining terms, “beach footwear” and “beach shoes”, i.e. footwear which is suitable for wearing on the beach, would encompass the opponent’s “flipflops” and are therefore identical.

“Clothing” and all of the applicant’s remaining goods under class 25

15. The general term “clothing” is identically found in the opponent’s registration. The remaining class 25 clothing goods applied for are all either identically captured within the opponent’s specifications or fall within the broad terms “clothing” and are therefore identical.

16. Finally, I will consider the applicant’s “parts, accessories or fittings for the aforesaid”. I will separate these out to consider parts and fittings together, then accessories. In relation to “parts... or fittings for the aforesaid”, these relate to constituent parts of the earlier named goods. As such, they have a different purpose to the opponent’s goods (all various types of clothing, footwear and headgear). Users of the goods overlap, but only to a degree, since fittings and parts may be purchased by the public at large (such as individuals who make, repair or customise their own clothes) but also by tradespeople who manufacture clothing. The trade channels typically differ in that they could be sold directly to

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<sup>4</sup> Paragraph 19 of written submissions.

trade or to the public via haberdashery shops, and in these instances they would not be expected to come from the same undertaking as clothing. However, the physical nature of the respective goods can overlap since they may be manufactured from the same materials and share the same colour. Parts and fittings can also be integral to the finished articles of clothing, footwear and headgear, for example when spare buttons, thread or heel tips are provided with the purchase of a piece of clothing or shoes. Therefore, in cases such as these, there is a degree of complementarity, shared trade channels and an expectation of them coming from the same undertaking. Overall, it is therefore considered that the goods have a low level of similarity with the opponent's goods.

17. Regarding "*accessories... for the aforesaid*", it is my view that these reference additional items which can be added to the earlier named goods. With respect to the opponent's goods (bearing in mind I have already found identity between the opponent's goods and the applicant's goods upon which the term "aforesaid" relates to) these would have the same users. Further, their nature and purpose overlap, to a degree, as the earlier goods are all clothing/footwear/headgear worn to cover the body and these accessories are also worn on the body/added to the worn goods to supplement or improve them in some manner. They would be sold through the same trade channels and appear in the same areas or nearby, with consumers likely to expect that they are made by the same or linked undertakings. The nature of an accessory is that it is a supplementary 'add-on', therefore I do not consider it essential to the goods for which it relates. I do not see the goods as complementary or in competition with each other. I consider that these would be similar to a medium degree to the opponent's goods.

18. I have already found identity across all the class 25 goods save for "*parts, accessories or fittings*" of those goods. There is nothing in the opponent's class 18 and 24 goods which would assist their case further in respect of this, therefore I do not consider it necessary to consider the applicant's class 25 goods with respect to the opponent's class 18 and 24 terms.

### **Class 35**

19. The opponent asserts that the applicant's (opposed) services in class 35 "would be considered identical, or at least, highly similar and complementary to" its own class 25 goods, since "the class 35 services simply cover the retail of class 25 goods".<sup>5</sup>
20. Firstly, I will deal with the applicant's class 35 services which correspond to goods for which I have found identical terms (directly or via *Meric*) in the opponent's earlier registration. That is all except for "*Mail order retail services, wholesale services, retail services or Internet retail services connected with the sale of parts, accessories or fittings for the aforesaid*".
21. Whilst I have found identity between the opponent's goods and the applicant's class 25 goods on which these services are based, it would, of course, be incorrect to treat these services as if they were the goods themselves. On this I am mindful that in *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the GC held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree. In *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services versus goods. As well as *Oakley*, this included *Sanco SA v OHIM*, Case C-411/13 P and *Assembled Investments (Proprietary) Ltd v OHIM*, Case T-105/05, (both of which were quoted by the opponent) and which was upheld on appeal in *Waterford Wedgwood Plc v Assembled Investments (Proprietary) Ltd*, Case C-398/07 P.
22. It is clear from this case law that where the applicant's retail services are to be compared to the opponent's goods, the retail services will be different in nature, purpose and method of use. Despite these differences, where there is some complementarity and shared trade channels, retail services may be similar to

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<sup>5</sup> Paragraph 22 of written submissions.

goods. It is also clear that complementarity alone is not sufficient for a finding of similarity where, from the consumer's point of view, the retail services of the applicant are unlikely to be offered by the same undertaking as the goods. Furthermore, I recognise that, while I must consider the retail services normally associated with the opponent's goods, I cannot treat the retail services as if they are goods.

23. With consideration to the above, it is my view that the contested retail services and wholesale services will undoubtedly be different in nature, purpose and method of use to the opponent's corresponding goods. However, I consider these to be complementary, on the basis that the goods will be essential for the retail services of those goods, and the consumer would expect that the goods and services originate from the same undertaking. Further, the trade channels and users will all overlap. Overall, I consider these contested retail and wholesale services similar to the opponent's earlier goods to a medium degree.

24. With respect to "*Mail order retail services, wholesale services, retail services or Internet retail services connected with the sale of parts, accessories or fittings for the aforesaid*", I consider the same logic will apply. Though bearing in mind that the goods that these services are based upon are not directly found within the opponent's registration, therefore the similarity is reduced. I consider these services for "*parts*" and "*fittings*" similar to the opponent's earlier goods to a low degree, and those for "*accessories*" similar to a low to medium degree.

25. I do not consider it necessary to consider the applicant's class 35 services with respect to the opponent's class 18 and 24 goods.<sup>6</sup> These goods are further away in similarity to the class 25 goods already considered, and therefore the comparison would not further the opponent's case.

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<sup>6</sup> Regarding the opponent's class 18 goods, I note that the applicant's class 35 services includes "Mail order retail services, wholesale services, retail services or Internet retail services connected with the sale of...Luggage, Bags, Wallets" however this has not been included in the scope of the oppositions and therefore is not relevant here.

## The average consumer and the nature of the purchasing act

26. As the case law indicates, it is necessary for me to determine who the average consumer is for the goods. I must then determine the manner in which these goods are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median”.

27. The opponent considers that the average consumer would be an ordinary member of the public since the goods are common and available to all. Since they are everyday items, it deems that they would be purchased frequently and with an average level of attention.<sup>7</sup> I agree with the assessment in relation to this being a member of the general public, though also note that the specific terms relating to “*parts... or fittings for the aforesaid*” may also be aimed at trade. I consider that the goods and/or services are likely to be accessed from signage on the high street, visiting a bricks and mortar shop and selected visually from the shelves, or from distance selling alternatives, such as the pages of a catalogue or online websites. Therefore, visual considerations are dominant. That said, word-of-mouth recommendations may also play a part in the selection process, with aural considerations playing a role. Overall, the goods and services are likely to be purchased relatively frequently (though I note that some items, such as “*suits*”, “*evening wear*” and “*gowns*” would be less regular); nevertheless, considerations

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<sup>7</sup> Under paragraph 22 of written submissions.

(for the goods) will be given to factors such as style, fit, colour, material or suitability of the products, demanding at least a medium degree of attention.


### Comparison of the marks

28. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

29. It would be wrong, therefore, to dissect the marks artificially, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

30. The respective marks are shown below:

Applicant's contested marks	Opponent's earlier mark
SOL SLEEP  SOL BEACH	

## **Overall Impression**

31. The applicant's marks are capitalised word only marks comprising two words, 'SOL SLEEP' and 'SOL BEACH'. The words 'SLEEP' and 'BEACH', whilst not negligible, are low in distinctive character since they are descriptive of the goods and services applied for (e.g. sleepwear and beachwear) and play a lesser role in the overall impression. Therefore, I consider that 'SOL' is the dominant and distinctive element of the marks. The opponent's mark is a subtly stylised word mark that consists of the text 'SOL'S' in which the overall impression resides. I note the stylised typeface of the earlier mark but this plays only a small role overall.

## **Visual similarity**

32. Both marks begin with the same three letters and in the same order, "SOL". The opponent states that the marks "coincide to a high degree" since 'SOL' is the first and dominant element across all the marks.<sup>8</sup> The apostrophe and final letter 'S' in the opponent's marks act as points of difference. I recognise, as a general rule, that the beginnings of marks are considered to have more impact.<sup>9</sup> However I think these extra characters will not be overlooked by the average consumer due to the short length of the mark and the fact that they grammatically transform it into a possessive noun.

33. The applicant's contested marks also both feature a second word ('SLEEP' and 'BEACH') for which there are no counterparts in the opponent's mark. Taking all of this into account and bearing in mind the overall impression of the marks, I am of the view that the applicant's contested marks are visually similar to the opponent's earlier mark to a medium degree.

## **Aural similarity**

34. The opponent submits that the marks "coincide to a very high degree". It asserts that the 'SOL' element will be pronounced identically across the marks.

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<sup>8</sup> Paragraph 32 of written submissions.

<sup>9</sup> As in *El Corte Inglés, SA v OHIM*.

Furthermore, that the “S’ element would be lost in pronunciation since it is at the end of the word”.<sup>10</sup> I agree that the ‘SOL’ element will be articulated the same across the marks. I consider the pronunciation of this will be ‘SOLL’ as in ‘DOLL’. However, I disagree with the notion that the second ‘S’ in the opponent’s mark will be lost. Since the mark is a possessive noun, it is my view that the letter ‘S’ following the apostrophe will also be heard in that mark, i.e. ‘SOLS’. In terms of the full pronunciation of the applicant’s marks, I consider that both ‘SOL’ and the second words (‘SLEEP’ or ‘BEACH’, respectively) will be articulated.

35. I find the applicant’s second mark, ‘SOL BEACH’, to be aurally similar to the opponent’s marks to a medium degree. I consider that the applicant’s first mark has a slightly higher similarity to the opponent’s mark. This is due to the first letter of the second word of that mark (‘SLEEP’) mirroring the last ‘S’ of ‘SOL’S’. In this case the pronunciation would run on between the two words, to sound like ‘SOLLS-SLEEP’. Therefore, I consider the applicant’s first mark aurally similar to the opponent’s earlier mark to a higher than medium degree.

### **Conceptual similarity**

36. The opponent argues that the ‘SOL’ and ‘SOL’S’ are “meaningless to the public with respect to the goods and services at issue” and thus as the dominant (or sole) elements of the marks, they are conceptually neutral.<sup>11</sup> I disagree with the blanket assessment that ‘SOL’ and ‘SOL’S’ are meaningless. Though I am mindful that for a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] E.C.R.-I-643; [2006] E.T.M.R 29. The assessment must, therefore, be made from the point of view of the average consumer. With this in consideration, I believe there are two likely scenarios regarding the interpretation of ‘SOL’ within the applicant’s contested marks:

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<sup>10</sup> Paragraph 33 of written submissions.

<sup>11</sup> Paragraph 34 of written submissions.

- that it would be perceived as an invented term or unknown foreign term with no immediate concept; or
- that it would be recognised as the Spanish word for sun. For example, as in the term “Costa del Sol”.

37. The second words in each of the applicant’s marks, ‘SLEEP’ and ‘BEACH’, are points of conceptual difference and would be attributed their normal dictionary meaning.

38. The opponent’s mark also has a conceptual difference as it is stylised as a possessive noun. I note that the opponent recognises this as part of its visual comparison of the marks (at paragraph 32 of its written submissions), but not in relation to its conceptual analysis. I consider that this plays a conceptual role and that it would not be overlooked by the consumer. The use of the apostrophe prior to the final ‘S’ provides the meaning ‘belonging to SOL’ and that ‘SOL’ would be interpreted as the name of an individual, character or thing. This is not a common forename in the UK therefore it is my view that the conceptual interpretations of ‘SOL’ in the paragraph above would also be applicable. For some, it will be perceived as an invented name, for others as a name for an individual or character of foreign origin and finally, some would perceive it as “belonging to the sun”.

39. Therefore, there are two interpretations of the dominant, common element ‘SOL’ by the average consumer. This would apply across all the marks, but with the caveat that each mark has an additional point of conceptual difference either via the addition of an extra word or being a possessive noun. Overall, I consider that the applicant’s contested marks are conceptually similar to the opponent’s earlier mark to a medium to high degree.

### **Distinctive character of the earlier mark**

40. Distinctive character is a measure of how strongly the earlier mark identifies the goods for which it is registered (and on which it may rely), determined, according to *Lloyd Schuhfabrik Meyer & Co.*, partly by assessing the proportion of the

relevant public which, because of the mark, identifies the goods as originating from a particular undertaking. At paragraph 23, of its judgment, the CJEU stated:

“In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).

41. The assessment as to whether there is a likelihood of confusion includes considering whether the distinctive character of the earlier mark has been enhanced (i.e. more distinctiveness has been acquired) through the use made of it. The opponent has not filed evidence about the use it has made of its mark. Consequently, I have only the inherent position to consider. It claims its mark is highly distinctive for the goods as it has no recognisable meaning and is not descriptive or allusive of its goods.<sup>12</sup> As I have noted above, I consider that ‘SOL’ (the common element across the marks) would be interpreted as an invented or foreign word of unknown meaning, or Spanish for ‘sun’. For those consumers who fall into the first group, the mark has a high level of inherent distinctive character. For consumers falling into the second group the mark is of average inherent distinctiveness.

## **GLOBAL ASSESSMENT – conclusions on likelihood of confusion**

42. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that

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<sup>12</sup> Under paragraph 22 of written submissions.

exists between the marks and the goods down to the responsible undertaking being the same or related.

43. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle, i.e. a lesser degree of similarity between the goods may be offset by a greater degree of similarity between the trade marks, and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing act. In doing so, I must take into account the fact that the average consumer rarely has an opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

44. To summarise my global assessment so far, I have found the parties' goods and services have at least a low similarity (with many goods being identical) and identified the average consumer to be a member of the general public (and trade, for those specifically relating to parts and fittings). They will select the goods primarily by visual means, although I do not discount the aural component. I have concluded that the degree of attention paid will be medium. I have found the parties' marks to be visually similar to a medium degree and to be aurally similar to a medium or higher than medium degree. The marks are conceptually similar to a medium-high degree. Finally, I have found the earlier mark to have a high or average degree of inherent distinctive character (depending on its interpretation).

45. The aural and conceptual similarities of the marks are clearly considerations in the opponent's favour. The opponent also argues that the dominant and distinctive element of the applicant's marks is 'SOL' since 'SLEEP' and 'BEACH' are descriptive of the goods and services applied for. I am inclined to agree because these additional words within the applicant's marks are terms commonly attributed to clothing, i.e. sleepwear and beachwear, and are therefore allusive of the applicant's goods and services. For both marks 'SOL SLEEP' and 'SOL BEACH', the two words within are independent elements and do not form a unit. As such, it is my view that consumers will see the second word in each mark as a

descriptor of the goods and services provided, and therefore will not attach much further significance to them.

46. In the applicant's favour is the additional "S" to the opponent's mark transforming it into a possessive noun. This provides a conceptual difference which is not replicated within the applicant's marks. However, the interpretation of this is 'belonging to SOL', therefore it serves to reinforce the common 'SOL' element. As identified in the caselaw above, I must also bear in mind that the consumer rarely has the chance to make direct comparisons between marks but instead relies on an imperfect recollection of them.

47. Taking all of this into account, I consider it likely that the marks will be mistakenly recalled or misremembered as each other, especially due to their conceptual proximity. I believe this remains the case even in relation to the goods and services of low similarity (parts and fittings, and retail thereof) due to the distinctiveness of the dominant 'SOL' element. The additional words in the contested marks are low in distinctive character and therefore would not be sufficient to distinguish them from that of the opponent. The additional element of the opponent's mark as a possessive noun is noted but serves to reiterate the 'SOL' concept. Thus, the distinctive and dominant element of the mark remains 'SOL' and the additional "S" could be misremembered by a consumer.

48. In case I am wrong in this finding, I will also consider whether there is any indirect confusion. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

"16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal

terms, is something along the following lines: 'The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark'.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)".

49. These examples are, clearly, not intended to be an exhaustive list but illustrate some of the circumstances in which indirect confusion may arise. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor KC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion. I am also mindful that a finding of indirect confusion should not be made merely

because the competing marks share a common element. In this connection, it is not sufficient that a mark merely calls to mind another mark.<sup>13</sup>

50. Applying these principles and taking into account all the above factors, I consider that even if the average consumer recognises the differences between the marks (e.g. notices and recalls the additional “S” in the opponent’s mark) and therefore does not mistake one mark for the other, that there will be an expectation on the part of the average consumer that the services at issue come from the same or economically linked undertakings. I believe this would be the case for all the opposed goods and services, including those of low similarity. As per the principles set out in *L.A. Sugar* cited above, in particular sub-paragraph (b), I consider that the applicant’s marks will be seen as indicative of an alternative mark or sub brand from the same or economically linked undertaking as the opponent’s mark. This is especially so, considering the goods and services are those where consumers are familiar with sub-brands and brand extensions.<sup>14</sup> Since ‘SLEEP’ and ‘BEACH’ are non-distinctive elements and allusive of the goods and services, they could readily be seen as brand extensions into sleepwear and beachwear.

## CONCLUSION

51. The oppositions are successful in relation to all the opposed goods and services, for which the applications are refused:

**Class 25:** *Clothing; Footwear; Headgear; Hooded sweatshirts; Shirts; Sweatshirts; T-shirts; Vests; Underwear; Hats; Berets; Knitted headwear; Sportswear; Dresses; Skirts; Blouses; Belts; Waist Belts; Coats; Jackets; Knitwear; Jumpers; Tights; Socks; Loungewear; Bathrobes; Capes; Evening wear; Gowns; Trousers; Shorts; Jeans; Suits; Neckwear; Nightwear; Outerclotthing; Rainwear; Ties; Pyjamas; Pajamas; Lingerie; Nightgowns; Nighties; Nightdresses; Sleepwear; Sleep masks; Sleeping garments; One-piece suits; Negligees; Beachwear; Beach clothing; Beach hats; Beach robes; Beach*

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<sup>13</sup> As per *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17.

<sup>14</sup> See paragraph 78 of the General Court decision in *Zero Industry Srl v OHIM*, Case T-400/06

*wraps; Beach footwear; Beach shoes; Beach cover-ups; Sandals; Flip-flops; Swimwear; Swimming costumes; Swimming trunks; Swimming suits; Sunsuits; Sun hats; Hats; parts, accessories or fittings for the aforesaid.*

**Class 35:** *Mail order retail services, wholesale services, retail services or Internet retail services connected with the sale of Clothing, Footwear, Headgear, Hooded sweatshirts, Shirts, Sweatshirts, T-shirts, Vests, Underwear, Hats, Berets, Knitted headwear, Sportswear, Dresses, Skirts, Blouses, Belts, Waist Belts, Coats, Jackets, Knitwear, Jumpers, Tights, Socks, Loungewear, Bathrobes, Capes, Evening wear, Gowns, Trousers, Shorts, Jeans, Suits, Neckwear, Nightwear, Outerclotthing, Rainwear, Ties, Pyjamas, Pajamas, Lingerie, Nightgowns, Nighties, Nightdresses, Sleepwear, Sleep masks, Sleeping garments, One-piece suits, Negligees, Beach clothing, Beach hats, Beach robes, Beach wraps, Beach footwear, Beach shoes, Beach cover-ups, Sandals, Flip-flops, Swimwear, Swimming costumes, Swimming trunks, Swimming suits, Sunsuits, Sun hats, Hats, parts, accessories or fittings for the aforesaid;*

52. The applications may proceed to registration in relation to the unopposed services:

**Class 35:** *Advertising; business management; business administration; office functions; Advertising, marketing, promotion or publicity services; Business advice, assistance or information services; Business management; Management advice, assistance or information services; Online advertising on computer networks; Sales promotion services; Mail order retail services, wholesale services, retail services or Internet retail services connected with the sale of Luggage, Bags, Wallets, parts, accessories or fittings for the aforesaid; Information, advice or consultancy services relating to the aforesaid.*

## **COSTS**

53. The opponent has been successful and is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2023. Taking into account the economies of consolidation after the defences were filed, I award the opponent the sum of £850.00, calculated as follows:

Fees for opposition forms	£200
Preparing a statement and considering the other side's statement (noting that these were identical across both oppositions)	£300
Preparing written submissions in lieu of a hearing	£350
<b>Total</b>	<b>£850</b>

54. I therefore order Frays Brands Ltd to pay Solo Invest the sum of **£850.00**. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

**Dated this 14<sup>th</sup> day of November 2025**

**C IRELAND**

**For the Registrar**